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10/028,580	12/20/2001	Brian R. Janes	01-659US	3268

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EXAMINER

LOWE, MICHAEL S

ART UNIT

PAPER NUMBER

3652

DATE MAILED: 06/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/028,580

Applicant(s)

JANES ET AL.

Examiner

M. Scott Lowe

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 36-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 March 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other:

Election/Restrictions

Claims 36-46 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 5.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 recites the limitation "said opening" in line 8. There is insufficient antecedent basis for this limitation in the claim.

Claims 5, 8, 12, 21, 24, 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear whether the "said member" referred to is the support member or the other member that is coupled to the platform. For sake of examination it is assumed that the "said member" is the member that is coupled to the platform.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the bucket must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-11, 13-27, 29-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Walth et al (US 6,158,949).

Re claims 1, 17, Walth teaches a load bearing arrangement for use with a work machine of the type having a platform 80, comprising:
at least one member 10 structured and arranged for coupling to the platform 80;
said member 10 having an end comprising a material having a first yield strength;
an aperture 70,54 formed in said end and having an aperture wall; at least one support member 56 contained within said opening adjacent to at least a portion of said aperture wall; and
said support member 56 having a second yield strength greater than said first yield strength.

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There is reason to believe, based on the similarity of (material, structure, etc.), that the functional limitation(s) of the second yield strength being greater than the first yield strength may be (an) inherent characteristic of work machine load bearing arrangements. In accordance with *In re Best*, 562 F.2d 1252, 195 USPQ 430, 433 (CCPA 1977):

[W]here the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

This "burden of rebutting [may be of] the PTO's reasonable assertion of inherency under 35 USC 102, or of prima facie obviousness under 35 USC 103" (195 USPQ at 432).

Accordingly, the burden is placed upon the applicant to prove that the yield strength limitations in question are not (an) inherent characteristic (s) of work machine load bearing arrangements.

Re claims 2, 18, Walth teaches the load bearing arrangement wherein said support member 56 comprises a substantially cylindrical structure having a through opening.

Re claims 3, 19, Walth teaches load bearing arrangement further comprising a bearing 56 received in said opening.

Re claims 4, 11, 20, 27, the added limitation of "laser welding" is rejected as adding no structure to the claims and is also an inherently taught characteristic of work machines.

Re claims 5, 21, Walth teaches load bearing arrangement wherein said member 10 comprises:

at least one top plate 16;

at least one bottom plate 18; and

at least one pair of spaced apart side plates 20, 21 each attached to said top plate 16 and said bottom plate 18.

Re claims 6, 22, Walth teaches load bearing arrangement wherein said top plate comprises at least one integral mounting structure (not numbered but shown on figures 2-4).

Re claims 7, 23, Walth teaches a load bearing arrangement comprising a substantially cylindrical attachment structure 50, 56 extending from at least one said side wall; and wherein said side wall is attached to said attachment structure 50, 56.

Re claims 8, 24, Walth teaches a load bearing arrangement wherein said member 10 has a transverse width; and said attachment structure 50, 56 spans said transverse width.

Re claims 9, 25, Walth teaches a load bearing arrangement further comprising at least one reinforcing structure 42 attached to at least one said side plate 20, 21.

Re claims 10, 26, Walth teaches a load bearing arrangement wherein said reinforcing structure comprises a base portion (not numbered); and a rib portion (not numbered) extending from said base portion.

Re claims 13, 14, 29, 30, 33, 34, Walth teaches a pivotally connected attachment bucket 82.

Re claim 15, Walth teaches a load bearing arrangement for use with a work machine of the type having a platform 80, comprising a plurality of pieces connectable to form a member 10 structured and arranged for pivotable attachment to the platform; a weldment (columns 3-4, etc.) connecting at least two of said pieces. The limitation "at least one said weldment being simulated for effects of heat on at least one of said pieces subject to said weldment" adds no structure and is thus not given any patentable weight.

Re claims 16, 35, the limitation is rejected as adding no further structure to the claims.

Re claim 31, Walth teaches a load bearing apparatus, comprising: a work machine having a platform 80; at first member 10, having a longitudinal axis, coupled to said platform 80; a first movement means (not numbered) for moving said first member 10 relative to said platform; a second member 68, having a longitudinal axis, pivotally coupled to said first member 10; a second movement means (not numbered) for moving said second member 68 relative to said first member 10; a plurality of pieces connectable to form at least one of said first and second members; a weldment connecting at least two of said pieces. The limitation "at least one said weldment being

simulated for effects of heat on at least one of said pieces subject to said weldment” adds no structure and is thus not given any patentable weight.

Re claim 32, Walth teaches first and said second movement means comprises hydraulic cylinders.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12, 28, are rejected under 35 U.S.C. 103(a) as being unpatentable over Walth et al (US 6,158,949) in view of Ginn et al (US 6,409,459).

Re claims 12, 28, Walth is silent as to whether the side plates are single or multi-piece structures. Ginn teaches in figure 7 a multi-piece side plate with collinear centerlines at the point of connection for the adjacent side plates. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Walth by Ginn to have a multi-piece side plate with collinear centerlines at the point of connection for the adjacent side plates to allow for easier construction by use of smaller and thus easier to handle sections.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Knell (US 4,428,173) teaches (figure 5) adjacent welded sections with collinear centerlines.

Waka (US 5,152,659) teaches a work machine boom assembly.

Neitzel et al (US 6,071,033) teaches the need for areas around the pin to have a higher yield strength than that of the rest of the boom structure.

Koshi et al (US 5,806,313) teaches use of brackets on booms, sticks to run conduit lines.

Price (US 4,214,923) teaches a method for constructing a boom structure.

Deneve et al (US 5,993,139) teaches multiple side plates.

Risch (US 5,111,602) teaches additional supports for boom, stick.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Scott Lowe whose telephone number is 703-305-1940. The examiner can normally be reached on 6:30am-4:30pm M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen Lillis can be reached on 703-308-3248. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

msl
May 27, 2003


DEAN J. KRAMER
PRIMARY EXAMINER